REMARKS/ARGUMENTS

The application has been carefully reviewed in light of the July 23, 2002 Office Action. In that Office Action, all claims 1-12, were rejected under 35 U.S.C. §102 (b) as being anticipated by Nichols et al. (U.S. Patent No. DES 3,995). In Response, Applicant has cancelled claims 5 and 10-12, amended claims 1 and 7, and added new claims 13-17, as well as providing the following argument. Applicant respectfully requests reconsideration and reexamination of the application, as amended.

EXTENSION OF TIME

Applicant submits herewith a Request for a Two-Month Extension, with pertinent fee.

CLAIM REJECTIONS

As noted above, the originally filed claims were rejected as being anticipate by Nichols et al. Nichols shows a design for a pruning shear. The pruning shear includes two portions A and B, comprising cutting jaws, which are united such that a gap or opening of uniform width results at every point between the two upon closing them together, resulting in the branch or twig being cut square off, without being forced by a shear motion towards the points. Within this gap is a spring secured to the blade A near the back, which is swept around to be near the cutting point for grasping whatever may

be cut by the blade. This spring B, is in the form of a "C", being doubled back upon itself as shown in the drawings.

It is well-known that there must be no difference between the claimed invention and the referenced disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 USPQ 2d 1001 (Fed.Cir. 1991). In determining anticipation, functional language, preambles, and language "whereby", "thereby", and "adapted to" clauses cannot be disregarded. *Pac-Tec, Inc. v. Amerace Corp.*, 14 USPQ 2d 1871 (Fed.Cir. 1990).

As recited in claims 1-4 and 6-9, the present invention resides in a surgical trimming tool. As discussed in the Specification, as well as recited in new claims 12-16, the surgical trimming tool is particularly adapted for use in a cranial-flap fixation system for removing excess stem extending from a tensioned cranial-flap clamp. The clip of the present invention is configured such so as to retain the cut stem between the jaws of the tool to prevent it from falling into the surgical site. This is accomplished by using only one hand of the surgeon. Accordingly, Applicant asserts that one of ordinary skill in the invention would view many differences between the claimed invention and the pruning shear of Nichols et al.

Independent claim 1 has been amended to include the recitation that the clip's first end is fixed to either the first or second jaw, and the second end of the clip extends over the jaw and has a sharpened edge. As discussed on Page 10 of the Specification, the sharpened edge of the clip facilitates the retention of the stem by cutting into a portion of the stem to more securely hold the stem in place. The spring of Nichols et al. is not

disclosed as being sharpened. Claims 4 and 7 recite that the clip is generally S-shaped. However, the spring of Nichols et al. is illustrated and described as being "C" shaped.

Claims 6 and 7 recite that the clip of the present invention is resiliently flexible and configured to flex upward as an object is cut to retain the object between the second end of the clip and the associated first or second jaw. There is no teaching or disclosure in the Nichols et al. reference that the spring be so configured. Such resilient flexibility facilitates the retention of the removed object between the jaws.

Independent claim 7 recites the first and second jaws are configured to contact and cooperatively define a cutting edge so as to cut an object when closed towards one another. Such is discussed on Page 10 of the Specification, and in Figures 16-18. Nichols et al. actually teaches away from such proposition by specifically disclosing that a gap be formed between the closed cutting jaws. By contacting and defining a cutting edge, the stem of the clamp is removed nearly flush with a top closure member of the clamp, preventing unsightly bumps and undue irritation when the scalp is placed over the cranium after the procedure.

Of course, for a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 15 USPQ 2d 1566 (Fed.Cir. 1990). As the Nichols et al. reference does not disclose every element of the claimed invention, as amended, it does not anticipate claims 1-4, and 6-9. Accordingly, Applicant asserts, claims 1-4 and 6-9 are patentably distinct from the cited references.

New claims 13-17 have been added to the application and directed to a cranial-flap fixation system positively reciting the use of a cranial-flap clamp, a tensioning tool, and a stem trimming tool as discussed above. The references are devoid of such a cranial-flap fixation system incorporating such a stem trimming tool. In neurosurgery applications, in particular, the stem trimming tool of the present invention is particularly useful as the clip mechanism is integral to the tool, so as not to be removable. The clip is non-obstructing and yet provides adequate clearance for cleaning and sterilization. It is specifically designed for the polymer stem retention to prevent ejection or falling of the trimmed segment into the surgical sight. The surgical trimming tool of the present invention saves time, complications, and unsightly bumps and irritation, and fulfills needs in this field. Accordingly, Applicant asserts that new claims 13-17 are novel and unobvious and thus patentable as well.

CONCLUSION

From the foregoing amendments and remarks, Applicant believes that pending claims 1-4, 6-9 and 13-17 are in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Claim(s) 5 and 10-12 have been canceled.

Claim(s) 1 and 7 have been amended as follows:

1. (Amended) A surgical trimming tool, comprising:

first and second handles pivotally attached to one another intermediate first and second ends thereof;

a first cutting jaw extending from the first end of the first handle;

a second cutting jaw extending from the first end of the second handle, wherein the first and second cutting jaws are configured to cut an object when closed towards one another; and

a clip [associated with] having a first end fixed to either the first or second cutting jaw and a second end extending over the jaw and having a sharpened edge [configured] to retain the cut object between the clip and the closed jaws until the first and second jaws are separated or the cut object is forcibly removed from the clip.

7. (Amended) A surgical trimming tool, comprising:

first and second handles pivotally attached to one another intermediate first and second ends thereof;

a first cutting jaw extending from the first end of the first handle;

a second cutting jaw extending from the first end of the second handle, wherein the first and second cutting jaws are configured to contact and cooperatively define a cutting edge so as to cut an object when closed towards one another;

a spring interposed between the first and second handles for biasing the first and second jaws into an open position; and

a generally S-shaped clip [attached at] having a first end thereof fixed to [the associated] either the first or second cutting jaw, with a second end extending over a cutting edge of the associated first or second jaw, wherein the clip is resiliently flexible and configured to flex upward as an object is cut so as to retain the object between the second end of the clip and

the associated first or second jaw [the clip being configured to retain the cut object between the clip and the closed jaws] until the first and second jaws are separated or the cut object is forcibly removed from the clip.

Add new claims 13-17 as follows:

13. A cranial-flap fixation system, comprising:

a cranial-flap clamp comprising a first closure member having a stem extending therefrom and a second closure member slidably attached to the stem so as to be moved towards the first closure member to lock a cranial flap to a skull;

a tensioning tool for tensioning the first and second closure member relative to one another; and

a stem trimming tool configured to remove excess stem extending from the second tensioned closure member, the trimming tool comprising:

a first cutting jaw extending from the first end of the first handle;

a second cutting jaw extending from the first end of the second handle, wherein the first and second cutting jaws are configured to cut an object when closed towards one another; and

a clip having a first end fixed to either the first or second cutting jaw and a second end extending over the jaw and configured to retain the cut object between the clip and the closed jaws until the first and second jaws are separated or the cut object is forcibly removed from the clip.

14. The system of claim 13, including a spring interposed between the first and second handles of the trimming tool for biasing the first and second jaws into an open position.

15. The system of claim 14, wherein the spring comprises first and second leaf springs, a first end of the first leaf spring being attached to the second end of the first handle, a first end of the second leaf spring being attached to the second end of the second handle, wherein the second ends of the first and second leaf springs are connected to each other.

16. The system of claim 13, wherein the clip is resiliently flexible and configured to flex upward as an object is cut so as to retain the object between the second end of the clip and the associated first or second jaw.

17. The system of claim 13, wherein the second end of the clip includes a sharp edge generally positioned over the cutting edge of the associated first or second jaw and adapted to partially cut into a portion of the stem to securely hold the removed stem within the jaws.